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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,108	07/11/2006	Ulf Dietrich	WAS0737PUSA	4368
22045 7590 11/24/2008 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075				
EXAMINER				
LEE, DORIS L				
ART UNIT		PAPER NUMBER		
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,108

Applicant(s)

DIETRICH ET AL.

Examiner

Doris L. Lee

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on August 26, 2008. Thus, the following action is properly made final.
2. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on August 26, 2008.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 103

4. **Claims 16-23, 25, and 27-29** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kinoshita et al (EP 1 090 901)**.

Regarding claim 16-20, Kinoshita teaches a dispersant (Abstract) comprising at least one copolymer ([0005]) consisting essentially of:

- a) 50-90 mol % of methacrylic acid ([0019]) which satisfies the limitation of component A
- b) 0.3 to 15 mol % of methallyl sulfonic acid ([0019]) which satisfies the limitation of component B
- c) 5-45 mol % of the polyetherester monomer ([0019]) where R' is a methyl group ([0011]) and the alkylene oxide units is from 7-90 repeat units ([0009]).

It is noted that the polyetherester monomer can be ethoxy polyethyleneglycol-polypropylene glycol ([0010]) which fulfills the limitations of the instantly claimed component C and D.

such that the total will be 100 molar %.

It would have been obvious to a person of ordinary skill in the art at the time of the invention, to use the above recited components in an amount that overlaps the claimed range amounts. It is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir. 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

Regarding claim 21, Kinoshita teaches that component D can be ethoxy polyethyleneglycol-polypropyleneglycol ([0010]) and it can be arranged by block connections ([0009]). It is noted that the repetition of oxyalkylene units is preferable 7-90 units ([0009]).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to evenly divide the repeating units of the oxyalkylene between the polyethylene glycol and polypropylene glycol, thus arriving at the instant claim.

When faced with a mixture, one of ordinary skill in the art would be motivated by common sense to select a 1:1 ratio, a ratio that falls within the presently claimed amount, absent evidence of unexpected or surprising results. Case law holds that "[h]aving established that this knowledge was in the art, the examiner could then properly rely... on a conclusion of obviousness, 'from common knowledge and common sense of the person of ordinary skill in the art within any specific hint or suggestion in a

particular reference.” *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Regarding claim 22, Kinoshita teaches that any known kinds of vinyl monomers can be used ([0018]) including vinyl aromatic monomers ([0018]).

Regarding claim 23, as Kinoshita teaches all the limitations of the dispersant of claim 16 and that it can be employed in a cement mixture ([0005]), it is therefore inherent that the prior art composition has the properties recited in the instant claim since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Regarding claim 25, Kinoshita teaches a cement composition in which the dispersant of claim 16 is used ([0005]).

Regarding claim 27, Kinoshita teaches that the dispersant of claim 16 can be used in Portland cement ([0043]).

Regarding claim 28, as the limitations “self-leveling floor filler or flowable screed” are intended use of the composition. Case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 29, as Kinoshita teaches all the components of the dispersant and the cement, it is therefore inherent that the dispersant displays a plasticizing action since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

5. **Claims 24 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Weitzel et al (US 6,127,283)** in view of **Kinoshita et al (EP 1 090 901)**.

Regarding claims 24 and 26, Weitzel teaches a process for spray drying of an aqueous polymer dispersion (col. 1, lines 7-12) in which vinyl acetate-ethylene (col. 2, lines 46-47) is used. It also teaches that a 2nd component, namely a water soluble copolymer containing sulfonic acids (col. 1, lines 50-58). Weitzel also teaches that this composition is used for the modification of cement-containing compositions and that when you spray dry the polymer dispersion; you reduce transport and storage capacity (col. 1, line 16).

However, it does not explicitly teach the copolymer of instant claim 16. Kinoshita teaches the composition of the composition of instant claim 16 as set forth above. Kinoshita also teaches that the composition acts as a dispersant for the cement ([0005]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the copolymer of Kinoshita in the spray drying process of Weitzel. One would have been motivated to do so in order to reduce the transport and storage capacity of a composition (Weitzel col. 1, line 16). They are combinable

because they are concerned with the same field of endeavor, namely polymers used in concrete. Absent objective evidence to the contrary and based upon teachings of the prior art, there would have been a reasonable expectation of success.

Response to Arguments

6. Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.
7. Since the Weitzel rejection has been carried over from the preceding action, it is appropriate to address applicant's arguments concerning that rejection.
8. The applicant argues that the copolymer containing sulfonic acid groups contain no pendent oxyethylene or oxypropylene groups and there is no teaching, suggestion or motivation that polymers containing polyoxyalkylene groups could be used by Weitzel in his process.

In response to the applicant's arguments, it is noted that now the dispersant is rejected over a new piece of art, Kinoshita, and therefore the question arises whether it is appropriate to combine Kinoshita with Weitzel to arrive at the instantly claimed invention. As the copolymer in Weitzel has a broad recitation (col. 1, lines 50-58) and includes some of the monomers of note in the instant claim 16 (such as vinylaromatic monomers (col. 2, line 3), 2-acrylamidopropanesulfonate (col. 2, line 19), methacrylic acid (col. 2, line 6) and hydroxylalkyl methacrylate (col. 2, line 40), it would have been obvious to one of ordinary skill in the art at the time of the invention to use a very similar copolymer, such as the one taught by Kinoshita and in the same field of endeavor, namely cementitious mixtures, as the copolymer of Weitzel. Although a motivation is

given in the rejection above, it is also noted that this falls under the "obvious to try" directive of the recent Supreme Court decision *KSR v. Teleflex*, 550 U.S. __, 82 USPQ2d 1385 (2007) and would amount to nothing more than a substitution of one known element for another to achieve predictable results.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796